REMARKS

In response to the above-identified Office Action ("Action"), Applicants traverse the Examiner's rejection of the claims and seek reconsideration thereof. Claims 38, 42-57 and 60-66 are pending in the present application. Claims 38, 42-57 and 60-66 are rejected. In this response, claims 38, 42, 46-53, 55 and 57 are amended, claims 43-45 are cancelled and no claims are added.

I. Claim Amendments

Claims 38 and 57 are amended to recite the oligonucleotide having SEQ. ID. NO. 4, which was previously recited in now cancelled claim 43. Claims 42 and 46-53 and 55 are amended for consistency with the amendments to claim 38. Applicants respectfully submit the amendments do not add new matter and are supported by the specification. Accordingly, Applicants respectfully request reconsideration and entry of the amendments to claims 38, 42, 46-53 and 57.

II. Claim Rejections – 35 U.S.C. §103

A. In the Action, claims 38, 42-57, and 60-67 are rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 95/02069 issued to Bennett et al. ("Bennett"), in view of Journal of Biological Chemistry, 1993, Vol. 268:16:11742-11749 of Park et al. ("Park").

To establish a *prima facie* case of obviousness, the Examiner must set forth "some articulated reasoning with some rational underpinning to support the conclusion of obviousness." See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103*, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

In regard to independent claims 38 and 57, Applicants respectfully submit that Bennett and Park fail to disclose or render predictable a method of depigmenting or bleaching human

skin, body hair or hair of a head including an oligonucleotide having SEQ ID NO. 4 as required by claims 38 and 57.

In the Action, the Examiner maintains the obviousness rejection in view of Bennett and Park, alleging that Bennett describes:

i) PKC beta-1 modulating specific oligonucleotides,
ii) psoriasis treatment (yet not necessary linked with PKC beta-1 isoform), and
iii) all the steps of the method of the invention.

The Examiner however acknowledges that Bennett does not describe that PKC beta-1 modulating oligonucleotides are efficient for skin bleaching or depigmenting (see Action, pg. 5). Nevertheless, the Examiner alleges that the claimed method is inherently performed by reducing to practice that which is disclosed in Bennett.

Applicants do not believe Bennett of Park disclose an oligonucleotide having SEQ ID NO. 4: GCC AGG ATC TGC ACC GTG AA. Bennett discloses on page 26 SEQ ID NO. 27: GCC AGC AT***G*** TGC ACC GTG AA, however, SEQ ID NO. 27 does not appear to be the same as SEQ ID NO. 4: GCC AGG AT***C*** TGC ACC GTG AA recited in original claim 43, and disclosed on page 20 of the Application.

Although Applicants have amended claims 38 and 57 to specify that the oligonucleotide has SEQ ID NO. 4 in an effort to expedite prosecution on this case, Applicants respectfully submit for the record that Applicants do not believe that the combination of Bennett and Park may be relied upon to disclose a method of depigmenting or bleaching human skin, let alone by using specifically a PKC beta-1 only modulating oligonucleotide.

In particular, Bennett discloses that, for the treatment of a particular disease, one of ordinary skill in the art should use oligonucleotides specific for one or more PKC isoforms that are known to be associated to this particular disease. In other words, specific oligonucleotides should be used depending on the knowledge concerning which PKC isoform(s) is/are associated to a particular disease.

It is thus clear from the global teaching of Bennett that oligonucleotides of Table 3 should be used for "diseases associated to PKC beta-1 only". Yet Bennett does not disclose any disease associated to PKC beta-1 only, let alone melanogenesis-linked diseases. The Examiner

has further not identified a document disclosing that melanogenesis-linked diseases are PKC beta-1 only associated diseases.

On the other hand, Park, which only refers to PKC beta in general, suggests that both PKC beta-1 and PKC beta-2 are involved in melanogenesis. This is also supported by the teachings of Nishizuka et al, which further discourages the person skilled in the art to target PKC beta-1 instead of PKC beta-2 (see Response to Office Action dated December 14, 2010).

In this context, Applicants found that the specific targeting of only PKC beta-1 is sufficient to inhibit melanogenesis. This particular effect on PKC beta-1 only is not taught nor suggested by any of the cited documents.

Since, for at least the foregoing reasons, the combination of Bennett and Park may not be relied upon to disclose each of the elements of claims 38 and 57, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 38 and 57 and their dependent claims under 35 U.S.C. §103 in view of Bennett and Park.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on March 14, 2011, Applicants respectfully petition Commissioner for a three (3) month extension of time, extending the period for response to September 14, 2011. The amount of $1,110.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) large entity will be charged to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: September 13, 2011

By: Stacie Sundquist
Stacie J. Sundquist, Reg. No. 53,654

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
Telephone (408) 720-8300
Facsimile (408) 720-8383

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on the date shown below.

Lareema Henderson — 9/13/2011 Date